

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARVEY J. DRAHEIM

Appeal No. 1999-2458
Application No. 08/851,693

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 10 and 17 to 20, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to crib dropside assemblies, and particularly to assemblies including dropsides movably mounted to corner posts by rail end fittings (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Burnham 1988	4,724,556	Feb. 16,
Huang 1995	5,432,962	July 18,

Claims 1 to 4 and 6 to 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Huang.

Claims 5 and 17 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Huang in view of Burnham.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

rejections, we make reference to the final rejection (Paper No. 6, mailed July 31, 1998) and the answer (Paper No. 10, mailed March 24, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief¹ (Paper No. 9, filed January 8, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 1 to 4 and 6 to 10 under 35 U.S.C. § 102(b) as being anticipated by Huang.

¹ The brief was submitted on legal size paper (i.e., 8½ by 14 inches). We note that 37 CFR § 1.52(b) does not permit the submission of a brief on legal size paper.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1 recites a crib dropside assembly comprising, inter alia, a corner post; a dropside movably mounted to the corner post and including an upper rail; a track coupled to the corner post; an end fitting mounted to the upper rail and including a track engagement member slidably mounted to the track; and a shielding member coupled to the end fitting. Claim 1 further recites that "said shielding member enclosing said track engagement member and adjoining said corner post such that substantially no gap is present between the end fitting and said corner post" (hereafter "the substantially no gap clause").

The appellant argues (brief, pp. 4-5) that Huang fails to teach, either expressly or by the doctrine of inherency, "the substantially no gap clause." We agree.

The examiner's position (answer, p. 3) with respect to "the substantially no gap clause" is that Figure 3 of Huang "does in fact illustrate substantially no gap between the corner post 605 and endfitting 20." We do not agree.

It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations

omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Here, the examiner's determination that Huang meets "the substantially no gap clause" is entirely speculative. It is our opinion that the examiner has not provided any evidence or scientific reasoning to establish the reasonableness of his belief that "the substantially no gap clause" of claim 1 is an inherent characteristic of Huang. In that regard, with respect to the perspective view seen in Figure 3 of Huang, we find that the size of the gap between the corner post 605 and the endfitting 20 is undeterminable. Furthermore, we agree with the appellant (brief, pp. 4-5) that the size of the gap between the corner post 605 and the endfitting 20 apparent from an examination of Figure 5 of Huang is of such a size as not to be readable on "the substantially no gap clause" of claim 1.

For the reasons set forth above, Huang does not meet all the limitations of claim 1 and therefore does not anticipate

claim 1. In light of the foregoing, the decision of the examiner to reject claim 1, as well as claims 2 to 4 and 6 to 10 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 5 and 17 to 20 under 35 U.S.C. § 103.

As set forth above, all the limitations of claim 1 are not taught by Huang. We have reviewed the additional applied prior art to Burnham but find nothing therein which would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have arrived at the claimed invention as set forth in claim 1. Specifically, the applied prior art does not teach or suggest "the substantially no gap clause" of claim 1. Accordingly, the decision of the examiner to reject dependent claims 5 and 17 under 35 U.S.C. § 103 is reversed.

With regard to independent claim 18, we agree with the appellant's argument (brief, p. 7) that the applied prior art to Huang and Burnham would not have made it obvious at the

time the invention was made to a person having ordinary skill in the art to have arrived at the claimed invention as set forth in claim 18. Specifically, we agree that the applied prior art does not teach or suggest the outer ends of the opposing walls of the shield "abutting said corner post" as recited in claim 18. In light of the foregoing, the decision of the examiner to reject claim 18, as well as claims 19 and 20 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 4 and 6 to 10 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 5 and 17 to 20 under

35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/851,693

APJ NASE

APJ FRANKFORT

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: Feb 7, 2000

FINAL TYPED: